

Amendment  
Serial No. 10/030,098  
Attorney Docket No. 011713

### **REMARKS**

Claims 1-11 are pending in the present application and are rejected. Claims 1, 4, 7 and 11 are herein amended. New claim 12 is added herein.

### **Priority**

In the Office Action of July 20, 2005, it was noted that although a copy of the PCT application has been received, a copy of the Japanese priority document is not present in the file. Applicants respectfully point out that the requirement in PCT Rule 17 for a certified copy of the foreign priority application is fulfilled by the applicant providing a certified copy to the receiving Office or to the International Bureau. Applicants herewith provide the Examiner a copy of the Notification of Receipt of Record Copy from the International Bureau indicating that the priority document has been received. Applicants respectfully request that the next Office communication indicate that all certified copies of the priority documents have been received.

### **Applicants' Response to Claim Objections**

Claims 4-6 were objected to because there was insufficient antecedent basis for "said user" recited in claim 4. In response, Applicants herein amend claim 4 in order to recite "a user." Favorable reconsideration is requested.

**Applicants' Response to Claim Rejections under 35 U.S.C. §103**

**Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. (U.S. Patent No. 6,108,639) in view of Official Notice.**

It is the position of the Office Action that Walker discloses the invention as claimed, with the exception of disclosing inputting an order for a surrogate investigation of said product from the user to said first information-processing apparatus, and transmitting an instruction on said surrogate investigation from said first information-processing apparatus to said second information processing apparatus. The Office Action relies on Official Notice to provide this teaching.

It is the position of the Office Action that Walker does however disclose the second information processing apparatus using product identification information to identify said product so as to conduct a physical identification of said identified product by an appointed agent, and providing information obtained from said identification to said user, presumably identified on the basis of the user identification. The Office Action takes Official Notice of the fact that it is well known for buyers to submit orders for services they wish to receive, related to products they seek to purchase.

Walker discloses a conditional purchase offer (CPO) management system for collectibles. This system is designed to provide a buyer-driven market for collectibles such as stamps, coins, or jewelry. First, a potential buyer enters a description of the desired goods into the central controller 200. This description may include the condition of the item, the price and the expiration date associated with the CPO. This acts as an offer to purchase an item. See column

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10, lines 5-13. Next, a search is performed for matching sellers. When a seller is found, the seller may then accept the CPO on the terms provided by the buyer. See column 11, lines 13-32. Alternatively, the seller may submit a counter offer which the buyer may then accept or refuse. See column 11, lines 47 to column 12, line 34.

Once a CPO is accepted, the item is physically shipped to a dealer/authenticator 150. The dealer/authenticator 150 validates that the item actually exists, and authenticates that it is in the condition stated by the seller and requested by the buyer. Optionally, the dealer/authenticator 150 may place a guarantee on the goods. The dealer/authenticator 150 also serves as a distribution point for the item. See column 5, lines 22-39.

If the dealer/authenticator 150 determines that the goods either cannot be validated or authenticated, the item is returned to the seller, the buyer is refunded his payment, and the seller may be charged a fee. See column 12, lines 35-58. On the other hand, if the dealer/authenticator 150 determines that the goods are valid and authentic, the buyer is contacted to pick up the item, or the item will be shipped to the buyer. The seller then receives payment for the item. See column 12, line 59 to column 13, line 7.

It is further noted that Walker briefly discloses an alternate embodiment where “the dealer/authenticator 150 or the collectible CPO management system 100 can attempt to complete a transaction between buyer and seller for the sub-grade goods, at a reduced price.” See column 12, lines 54-58. Walker provides no further explanation or disclosure of this alternate embodiment.

Applicants respectfully submit that the primary embodiment of Walker does not disclose or suggest “providing information from said investigation to said user identified on the basis of said user identification information.” Upon validation or invalidation, the buyer is provided either with a refund or delivery of the item. No information from the physical investigation is provided from the dealer/authenticator 150 to the buyer. However, it appears that the alternate embodiment may be broadly interpreted to teach a provision of information from the physical investigation to the buyer.

Therefore, the present claims recite that “said product is in a seller’s possession at a time of said investigation.” As discussed above, Walker discloses the shipment of a product to a dealer/authenticator 150. On the other hand, the present invention requires that the physical inspection be performed by an agent 105a who visits a real store 104. Thus, the product is still in the possession of the seller when the agent performs the physical investigation. This method places less of a burden on the seller and removes the time, expense, and risk of shipping items to an agent. Furthermore, the claimed method allows for inspection of products which are impractical or expensive to ship, such as an automobile or other large items. Applicants respectfully submit that claim 1 is patentable over Walker for at least this reason.

It is noted, however, that the second embodiment of the present invention, which is illustrated in Figure 6, does not disclose that the agent 105a visits a physical store. Instead, a dealer 601 ships a sample 601a to a warehouse 602, where the investigation agent 105a performs a physical investigation. Thus, the product is not in the possession of the seller at the time of the physical investigation. This method is useful for dealers who do not have a real store, and greatly

reduces the travel expenses and number of agents required. Sample 601a is representative of many identical products. Thus, Applicants herein add new claim 12 which recites that “said product is a representative sample of a plurality of products.” Applicants respectfully submit that this distinguishes over Walker.

Instead of providing for a sample of a product, Walker teaches that the dealer/authenticator 150 determines whether a collectible item such as a coin, stamp, or jewelry is real and in the condition described by the seller. Collectible items such as these are by nature of differing quality and condition, since they are used products. A sample of a particular collectible would not be representative of a plurality of products. Thus, Applicants respectfully submit that new claim 12 is patentable over Walker for at least this reason.

With regard to the taking of Official Notice, Applicants acquiesce that “it is well known for buyers to submit orders for services they wish to receive.” However, Applicants respectfully submit that this Official Notice does not provide for the teachings which the Office Action states that Walker lacks. That is, “inputting an order for a surrogate investigation of said product from the user to said first information-processing apparatus, and transmitting an instruction on said surrogate investigation from said first information-processing apparatus to said second information processing apparatus.” Thus, the combination of Official Notice and Walker does not disclose the invention as claimed. Favorable reconsideration is respectfully requested.

**Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. in view of Official Notice, and in further view of Vanechanos, Jr. (U.S. Patent No. 5,884,309).**

It is the position of the Office Action that the combination of Walker and Official Notice discloses the invention as claimed, with the exception of a step of publishing information for designating a store and information about products dealt by said store on the network including first and second information-processing apparatus, wherein said user identifies a product for purchase among said published products. The Office Action states that this is a description of standard electronic commerce in a virtual mall, as taught by Vanechanos. In response, Applicants respectfully submit that claim 2 is patentable due to its dependency on claim 1, which Applicants submit is patentable for at least the reasons discussed above. Favorable reconsideration is respectfully requested.

**Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. in view of Official Notice or over Walker in view of Vanechanos and Official Notice.**

It is the position of the Office Action that Walker teaches the invention as claimed, with the exception of disclosing that the step of inputting an order for a surrogate investigation includes designating the level of said investigation or a deadline for the answer of said investigation. However, the Office Action states that Walker discloses different levels of investigation (validation, authentication, and guarantee). In response, Applicants respectfully submit that claim 3 is patentable due to its dependency on claims 1 or 2, which Applicants

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submit are patentable for at least the reasons discussed above. Favorable reconsideration is respectfully requested.

**Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. in view of Official Notice.**

As with claim 1, it is the position of the Office Action that Walker discloses the invention as claimed, with the exception of disclosing inputting an order for a surrogate investigation of said product from the user to said first information-processing apparatus, and transmitting an instruction on said surrogate investigation from said first information-processing apparatus to said second information processing apparatus. The Office Action relies on Official Notice to provide this teaching. In response, Applicants respectfully submit that amended claim 4 is patentable for reasons similar to that of claim 1, as discussed above. Further, Applicants respectfully submit that the taking of Official Notice is insufficient for similar reasons as discussed above with regard to claim 1.

Additionally, it is noted that the Office Action states that claims 4-6 “are not treated as invoking 35 U.S.C. §112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. §112, sixth paragraph, Applicant should provide an explicit statement to that effect.” However, claim recitations are automatically interpreted in accordance with 35 U.S.C. § 112, sixth paragraph if they are recited in “means plus function” form. Since the limitations of claims 4-6 are presented in a “means plus function” format, they should be properly construed under 35 U.S.C. §112, sixth paragraph. Favorable reconsideration is respectfully requested.

**Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. in view of Official Notice, and in further view of Vanechanos.**

It is the position of the Office Action that the combination of Walker and Official Notice discloses the invention as claimed, with the exception of disclosing that the acquiring means is operable to acquire the identification information of a product for purchase and the order in parallel with publishing information for designating a store and information about products dealt by said store on the network to provide said products to the user. The Office Action states that this is a description of standard electronic commerce in a virtual mall, as taught by Vanechanos. In response, Applicants respectfully submit that claim 5 is patentable due to its dependency on amended claim 4, which Applicants submit is patentable for at least the reasons discussed above. Favorable reconsideration is respectfully requested.

**Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. in view of Official Notice or over Walker in view of Vanechanos and Official Notice.**

It is the position of the Office Action that Walker teaches the invention as claimed, with the exception of disclosing that the acquiring means is operable to acquire designated information about the level of said investigation or a deadline for the answer of said investigation. However, the Office Action states that Walker discloses different levels of investigation (validation, authentication, and guarantee). In response, Applicants respectfully submit that claim 6 is patentable due to its dependency on claims 4 or 5, which Applicants



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submit are patentable for at least the reasons discussed above. Favorable reconsideration is respectfully requested.

**Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. in view of Official Notice.**

As with claims 1 and 4, it is the position of the Office Action that Walker discloses the invention as claimed, with the exception of disclosing inputting an order for a surrogate investigation of said product from the user to said first information-processing apparatus, and transmitting an instruction on said surrogate investigation from said first information-processing apparatus to said second information processing apparatus. The Office Action relies on Official Notice to provide this teaching. In response, Applicants respectfully submit that claim 7 is patentable for at least reasons similar to that of claims 1 and 4, as discussed above. Further, Applicants submit that the taking of Official Notice is insufficient for similar reasons as discussed above with regard to claims 1 and 4.

Further, the Office Action notes that “as claim 7 is directed to claiming a server apparatus, it is doubtful whether features of the terminal to which the server apparatus is to be connected could be a basis for patentability in any event.” In response, Applicants herein amend claim 7 in order to make the claim directed to an information service system comprising a server apparatus and an information-processing terminal. This ensures that the features of both the server apparatus and the information-processing terminal are given patentable weight.

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Additionally, it is noted that the Office Action states that claims 7 and 8 “are not treated as invoking 35 U.S.C. §112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. §112, sixth paragraph, Applicant should provide an explicit statement to that effect.” However, claim recitations are automatically interpreted in accordance with 35 U.S.C. § 112, sixth paragraph if they are recited in “means plus function” form. Since the limitations of claims 7 and 8 are presented in a “means plus function” format, they should be properly construed under 35 U.S.C. §112, sixth paragraph. Favorable reconsideration is respectfully requested.

**Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. in view of Official Notice, and in further view of the Microsoft Press Computer Dictionary.**

It is the position of the Office Action that Walker discloses the invention as claimed, with the exception of disclosing a computer readable medium storing a program to be read in and executed on a computer is used to implement the server apparatus. The Office Action relies on the definitions of “program,” “disc,” and “disk” in the Microsoft Press Computer Dictionary to provide this teaching. In response, Applicants respectfully submit that claim 8 is patentable due to its dependency on claim 7, which Applicants submit is patentable for at least the reasons discussed above. Favorable reconsideration is respectfully requested.

**Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. in view of Official Notice.**

As with claims 1, 4 and 7, it is the position of the Office Action that Walker discloses the invention as claimed, with the exception of disclosing inputting an order for a surrogate investigation of said product from the user to said first information-processing apparatus, and transmitting an instruction on said surrogate investigation from said first information-processing apparatus to said second information processing apparatus. The Office Action relies on Official Notice to provide this teaching. In response, Applicants respectfully submit that claim 9 is patentable for reasons similar to that of claims 1, 4 and 7, as discussed above. Further, Applicants submit that the taking of Official Notice is insufficient for at least similar reasons as discussed above with regard to claims 1, 4 and 7.

Similar to claim 7, the Office Action notes that “as claim 9 is directed to claiming an information-processing terminal, it is doubtful whether features of the server apparatus to which the information-processing terminal is to be connected could be a basis for patentability in any event.” In response, Applicants herein amend claim 9 in order to make the claim directed to an information service system comprising an information-processing terminal and a server apparatus. This ensures that the features of both the information-processing terminal and the server apparatus are given patentable weight.

Additionally, similar to claim 9, it is noted that the Office Action states that claims 9 and 10 “are not treated as invoking 35 U.S.C. §112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. §112, sixth paragraph, Applicant should provide an explicit statement to that effect.”

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However, claim recitations are automatically interpreted in accordance with 35 U.S.C. § 112, sixth paragraph if they are recited in “means plus function” form. Since the limitations of claims 9 and 10 are presented in a “means plus function” format, they should be properly construed under 35 U.S.C. §112, sixth paragraph. Favorable reconsideration is respectfully requested.

**Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. in view of Official Notice, and in further view of the Microsoft Press Computer Dictionary.**

It is the position of the Office Action that Walker discloses the invention as claimed, with the exception of disclosing a computer readable medium storing a program to be read in and executed on a computer is used to implement the server apparatus. The Office Action relies on the definitions of “program,” “disc,” and “disk” in the Microsoft Press Computer Dictionary to provide this teaching. In response, similar to claim 8, Applicants respectfully submit that claim 10 is patentable due to its dependency on claim 9, which Applicants submit is patentable for at least the reasons discussed above. Favorable reconsideration is respectfully requested.

**Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. in view of Official Notice.**

As with claims 1, 4, 7 and 9, it is the position of the Office Action that Walker discloses the invention as claimed, with the exception of disclosing inputting an order for a surrogate investigation of said product from the user to said first information-processing apparatus, and

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transmitting an instruction on said surrogate investigation from said first information-processing apparatus to said second information processing apparatus. The Office Action relies on Official Notice to provide this teaching. In response, Applicants respectfully submit that claim 11 is patentable for at least reasons similar to that of claims 1, 4, 7 and 9, as discussed above. Further, Applicants submit that the taking of Official Notice is insufficient for similar reasons as discussed above with regard to claim 1, 4, 7 and 9. Favorable reconsideration is respectfully requested.

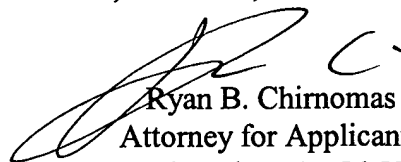
For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned agent.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**



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RBC/jl

Enclosure: Copy of Notification of Receipt of Record Copy

# PATENT COOPERATION TREATY

From the INTERNATIONAL BUREAU

**PCT**

## NOTIFICATION OF RECEIPT OF RECORD COPY

(PCT Rule 24.2(a))

To:

OHT INC.  
1118-1, Aza-Nishichujo  
Kannabe-cho  
Fukayasu-gun  
Hiroshima 720-2103  
JAPON

<b>Date of mailing (day/month/year)</b> 18 June 2001 (18.06.01)	<b>IMPORTANT NOTIFICATION</b>
<b>Applicant's or agent's file reference</b> OHTPCT10	<b>International application No.</b> PCT/JP01/04099

The applicant is hereby notified that the International Bureau has received the record copy of the international application as detailed below.

Name(s) of the applicant(s) and State(s) for which they are applicants:

OHT INC. (for all designated States except US)  
ISHIOKA, Shogo et al (for US)

International filing date : 17 May 2001 (17.05.01)  
Priority date(s) claimed : 17 May 2000 (17.05.00)  
Date of receipt of the record copy  
by the International Bureau : 01 June 2001 (01.06.01)  
List of designated Offices :

EP : AT, BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE, TR  
National : CA, CN, KR, SG, US


### ATTENTION

The applicant should carefully check the data appearing in this Notification. In case of any discrepancy between these data and the indications in the international application, the applicant should immediately inform the International Bureau.

In addition, the applicant's attention is drawn to the information contained in the Annex, relating to:

- ☒ time limits for entry into the national phase
- ☒ confirmation of precautionary designations
- ☒ requirements regarding priority documents

A copy of this Notification is being sent to the receiving Office and to the International Searching Authority.

<b>The International Bureau of WIPO</b> 34, chemin des Colombettes 1211 Geneva 20, Switzerland	<b>Authorized officer:</b>  Y. KUWAHARA
Facsimile No. (41-22) 740.14.35	Telephone No. (41-22) 338.83.38

## INFORMATION ON TIME LIMITS FOR ENTERING THE NATIONAL PHASE

The applicant is reminded that the "national phase" must be entered before each of the designated Offices indicated in the Notification of Receipt of Record Copy (Form PCT/IB/301) by paying national fees and furnishing translations, as prescribed by the applicable national laws.

The time limit for performing these procedural acts is **20 MONTHS** from the priority date or, for those designated States which the applicant elects in a demand for international preliminary examination or in a later election, **30 MONTHS** from the priority date, provided that the election is made before the expiration of 19 months from the priority date. Some designated (or elected) Offices have fixed time limits which expire even later than 20 or 30 months from the priority date. In other Offices an extension of time or grace period, in some cases upon payment of an additional fee, is available.

In addition to these procedural acts, the applicant may also have to comply with other special requirements applicable in certain Offices. **It is the applicant's responsibility** to ensure that the necessary steps to enter the national phase are taken in a timely fashion. Most designated Offices do not issue reminders to applicants in connection with the entry into the national phase.

For detailed information about the procedural acts to be performed to enter the national phase before each designated Office, the applicable time limits and possible extensions of time or grace periods, and any other requirements, see the relevant Chapters of Volume II of the PCT Applicant's Guide. Information about the requirements for filing a demand for international preliminary examination is set out in Chapter IX of Volume I of the PCT Applicant's Guide.

GR and ES became bound by PCT Chapter II on 7 September 1996 and 6 September 1997, respectively, and may, therefore, be elected in a demand or a later election filed on or after 7 September 1996 and 6 September 1997, respectively, regardless of the filing date of the international application. (See second paragraph above.)

Note that only an applicant who is a national or resident of a PCT Contracting State which is bound by Chapter II has the right to file a demand for international preliminary examination.

## CONFIRMATION OF PRECAUTIONARY DESIGNATIONS

This notification lists only specific designations made under Rule 4.9(a) in the request. It is important to check that these designations are correct. Errors in designations can be corrected where precautionary designations have been made under Rule 4.9(b). The applicant is hereby reminded that any precautionary designations may be confirmed according to Rule 4.9(c) before the expiration of 15 months from the priority date. If it is not confirmed, it will automatically be regarded as withdrawn by the applicant. There will be no reminder and no invitation. Confirmation of a designation consists of the filing of a notice specifying the designated State concerned (with an indication of the kind of protection or treatment desired) and the payment of the designation and confirmation fees. Confirmation must reach the receiving Office within the 15-month time limit.

## REQUIREMENTS REGARDING PRIORITY DOCUMENTS

For applicants who have not yet complied with the requirements regarding priority documents, the following is recalled.

Where the priority of an earlier national, regional or international application is claimed, the applicant must submit a copy of the said earlier application, certified by the authority with which it was filed ("the priority document") to the receiving Office (which will transmit it to the International Bureau) or directly to the International Bureau, before the expiration of 16 months from the priority date, provided that any such priority document may still be submitted to the International Bureau before that date of international publication of the international application, in which case that document will be considered to have been received by the International Bureau on the last day of the 16-month time limit (Rule 17.1(a)).

Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to prepare and transmit the priority document to the International Bureau. Such request must be made before the expiration of the 16-month time limit and may be subjected by the receiving Office to the payment of a fee (Rule 17.1(b)).

If the priority document concerned is not submitted to the International Bureau or if the request to the receiving Office to prepare and transmit the priority document has not been made (and the corresponding fee, if any, paid) within the applicable time limit indicated under the preceding paragraphs, any designated State may disregard the priority claim, provided that no designated Office may disregard the priority claim concerned before giving the applicant an opportunity to furnish the priority document within a time limit which is reasonable under the circumstances.

Where several priorities are claimed, the priority date to be considered for the purposes of computing the 16-month time limit is the filing date of the earliest application whose priority is claimed.

# PATENT COOPERATION TREATY

From the INTERNATIONAL BUREAU

PCT

## NOTIFICATION CONCERNING SUBMISSION OR TRANSMITTAL OF PRIORITY DOCUMENT

(PCT Administrative Instructions, Section 411)

To:

OHT INC.  
1118-1, Aza-Nishichujo  
Kannabe-cho  
Fukayasu-gun  
Hiroshima 720-2103  
JAPON

Date of mailing (day/month/year) 22 August 2001 (22.08.01)	
Applicant's or agent's file reference OHTPCT10	<b>IMPORTANT NOTIFICATION</b>
International application No. PCT/JP01/04099	International filing date (day/month/year) 17 May 2001 (17.05.01)
International publication date (day/month/year) Not yet published	Priority date (day/month/year) 17 May 2000 (17.05.00)
Applicant OHT INC. et al	

1. The applicant is hereby notified of the date of receipt (except where the letters "NR" appear in the right-hand column) by the International Bureau of the priority document(s) relating to the earlier application(s) indicated below. Unless otherwise indicated by an asterisk appearing next to a date of receipt, or by the letters "NR", in the right-hand column, the priority document concerned was submitted or transmitted to the International Bureau in compliance with Rule 17.1(a) or (b).
2. This updates and replaces any previously issued notification concerning submission or transmittal of priority documents.
3. An asterisk(\*) appearing next to a date of receipt, in the right-hand column, denotes a priority document submitted or transmitted to the International Bureau but not in compliance with Rule 17.1(a) or (b). In such a case, the attention of the applicant is directed to Rule 17.1(c) which provides that no designated Office may disregard the priority claim concerned before giving the applicant an opportunity, upon entry into the national phase, to furnish the priority document within a time limit which is reasonable under the circumstances.
4. The letters "NR" appearing in the right-hand column denote a priority document which was not received by the International Bureau or which the applicant did not request the receiving Office to prepare and transmit to the International Bureau, as provided by Rule 17.1(a) or (b), respectively. In such a case, the attention of the applicant is directed to Rule 17.1(c) which provides that no designated Office may disregard the priority claim concerned before giving the applicant an opportunity, upon entry into the national phase, to furnish the priority document within a time limit which is reasonable under the circumstances.

<u>Priority date</u>	<u>Priority application No.</u>	<u>Country or regional Office or PCT receiving Office</u>	<u>Date of receipt of priority document</u>
17 May 2000 (17.05.00)	2000-145297	JP	06 July 2001 (06.07.01)

<p>The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland</p> <p>Facsimile No. (41-22) 740.14.35</p>	<p>Authorized officer Taïeb AKREMI</p> <p>Telephone No. (41-22) 338.83.38</p>
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